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OFFICE OF PETITIONS

In re Application of
Nelms, et al.
Application No. 10/085,454
Filed: February 27, 2002
Attorney Docket No. DSC-7A
For: NON-RECTANGULAR SHAPED CREDIT
CARD WITH CASE

:
: DECISION ON PETITIONS
: UNDER 37 CFR §1.78(a)(3) &
: 37 CFR §1.48(a)
:

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed July 29, 2005 (certificate of mailing date July 27, 2005), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment. In addition, the decision will address the petition under 37 CFR 1.48(a), filed November 15, 2002 (certificate of mailing date November 11, 2002).

The petition under 37 CFR 1.48(a) is **GRANTED**.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

PETITION UNDER 37 CFR 1.48(a)

An executed declaration in compliance with 37 CFR 1.63 was filed on June 6, 2002. The executed declaration listed three inventors – Nelms, Schick, and Wilson. The instant Rule 48(a) petition was filed to correct the inventorship by adding Roger C. Hochschild as a joint inventor.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from *each person being added* and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the fee set forth in 37 CFR 1.17 (i); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Petitioners have satisfied the above-listed requirements. The petition under 37 CFR 1.48(a) is **granted**.

PETITION UNDER 37 CFR 1.78(a)(3)

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in §1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application – application no. 29/133,861, filed December 8, 2000 -- has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. In addition, application No. 10/085,454 and application No. 29/133,861 now have an inventor in common since the Rule 48(a) petition was granted. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

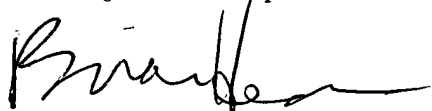
The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of

priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application and lists Roger C. Hochschild as a joint inventor, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3611 for appropriate action on the amendment filed July 29, 2005 (certificate of mailing date July 27, 2005), including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.

A handwritten signature in black ink, appearing to read "Brian Hearn", with a stylized flourish at the end.

Brian Hearn
Special Projects Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt